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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,316	09/23/2003	Hiroki Hayashi	00684.003529.	9263
5514	7590	05/03/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			VO, ANH T N	
			ART UNIT	PAPER NUMBER
			2861	

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary

Application No.

10/667,316

Applicant(s)

HAYASHI ET AL.

Examiner

Anh T.N. Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/12/04 & 12/7/04</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

The references cited on PTO 1449 have been considered.

Specification

The specification has been checked to the extent necessary to determine the presence of all possible minor errors. However, the applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Objection

Claim 9 is objected to in that "9" at line 3 should be changed to --8--. Appropriate correction is required.

Double patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 12-27, 32-33, 35-49, 51, 54-61 of US Patent number 6,361,158 and 1-15 of Application number 10/667,314. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim an ink container for containing ink to be supplied to an ink jet head and engaging with a tank holder comprising:

- an ink jet head;
- an ink tank;
- an ink supply port;
- a tank holder;
- a lever;
- a fixing member having first and second engagement portions
- a fiber member; and
- an air vent.

This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

CLAIM REJECTIONS

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 8 are rejected under 35 USC 102 (b) as being anticipated by Inoue et al. (US Pat. 5,619,237).

Inoue et al. disclose in Figures 5-6, 14-16, 20, 23-24, 28a-28b, 45-46 and 62-63 an ink jet recording apparatus comprising:

- a casing (142) having a substantially rectangular shape;
- a plurality of ink accommodating portions defined by partition (142f) in said casing (142) (Figure 24);
- ink supply ports (142bY, 142bM, 142bC) provided, in a bottom side of said casing, for said ink accommodating portions; respectively (Figure 25, column 22, lines 3-7);
- wherein said ink container (140) is detachably mountable to a holder (160) provided with a recording head (150) portion for ejecting ink accommodated in said ink accommodating portion, wherein said plurality of ink supply ports are disposed deviated toward one of long edge of the bottom side; and a plurality of dimple portions in which said supply ports are formed, respectively, and said dimples are cut away and open adjacent to said one of edges (Figures 20 and 27).
- mounting engageable members (142a, 142d) at respective positions such as to interpose said plurality of supply ports therebetween, wherein as seen from a top of said ink container (140), a phantom straight line connecting centers of said mounting engageable members crosses with all of said plurality of supply ports (Figures 20-26);
- wherein one of said mounting engageable members (142a, 142d) includes an engaging claw (142d) provided on a side surface of said casing, and the other is an engaging claw (142e)

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provided on a lever (142a) extending from said casing, and wherein such one of ink supply ports as is closest to said engaging claw (142bC) provided on said side surface of said casing is deviated toward said partition (Figures 24-26);

- wherein each of said ink accommodating portion includes an air vent (131b) for fluid communication between inside of said ink accommodating portions and an ambience, a first liquid retaining member (135 or 1002) in the form of a sheet (Figures 23-24 and 45-46, column 20, line 3 and column 22, lines 8-15);
- a second liquid retaining member (133 or 1000) closely contacted to said first liquid retaining member (135 or 1002) to supply the ink therefrom to said first liquid retaining member (135 or 1002), wherein said first liquid retaining member (135 or 1002) has a liquid retaining force which is larger than that of said second liquid retaining member (1000) (Figures 45-46);
- wherein with said ink container (130, 140) mounted to a holder (160), said first and second liquid retaining members (135, 133 or 1002, 1000) are maintained deformed by an ink receiving tube provided in the holder (160);
- wherein said first liquid retaining member (1002) is a lamination member of fibers, and a laminating direction of the lamination member is substantially the same as an abutting direction of the external member (ink tube) (Figures 45-46);
- a recording head portion (150) for receiving the ink from said ink container (130, 140) held in said holder (160) and for ejecting ink droplets (Figures 23-24);
- wherein the ink droplets are ejected from said ink jet recording head (150) onto a recording material (paper but not shown) to effect recording on the recording material.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made

to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Inoue et al. (US Pat. 5,619,237) in view of Ardito et al. (US Pat. 6,776,479).

Inoue et al. disclose the basic features of the claimed invention were stated above but does not disclose the liquid retaining member which extends on an inner bottom surface of said casing substantially along an inner configuration of the bottom surface and which is capable of being abutted by an external member through said ink supply.

Ardito et al. disclose in Figures 2-6 an ink container (12) comprising the liquid retaining member (222) which extends on an inner bottom surface of said casing (202) substantially along an inner configuration of the bottom surface and which is capable of being abutted by an external member through said ink supply port (212).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the teaching of Ardito et al. in the Inoue et al. ink container for the purpose of enabling absorption of residual fluid into the fiber that occupies the inner space of the ink container.

Claims 4-7 are rejected under 35 U.S.C. 103 (a) as being unpatentable over Inoue et al. (US Pat. 5,619,237) in view of Higuma et al. (US Pat. 6,137,512).

Inoue et al. disclose the basic features of the claimed invention were stated above but does not disclose the liquid retaining member which extends on an inner bottom surface of said casing substantially along an inner configuration of the bottom surface and which is capable of being abutted by an external member through said ink supply.

Higuma et al. disclose in Figures 1-2 and 9 an ink container (1) comprising the liquid

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retaining member (40b) which extends on an inner bottom surface of said casing substantially along an inner configuration of the bottom surface and which is capable of being abutted by an external member through said ink supply port (8).

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to incorporate the teaching of Higuma et al. in the Inoue et al. ink container for the purpose of increasing ink retaining capacity of the fiber that occupies the inner space of the ink container.

Citation of Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. These prior art references (US Pat. 5,010,354; US Pat. 5,703,633; US Pat. 6,742,881; US Pat. 6,827,431) cited in the PTO 892 form show an ink container that is deemed to be relevant to the present invention. These references should be reviewed.

CONCLUSION

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Anh Vo. whose telephone number is (703) 305-8194. The examiner can normally be reached on Monday to Friday from 8:00 A.M. to 4:00 P.M. The fax number of this Group 2861 is (703) 305-3431 or 305-3432.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0956.


ANH TIN VO
PRIMARY EXAMINER

April 28, 2005